

ESTTA Tracking number: **ESTTA652188**

Filing date: **01/26/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92059915
Party	Plaintiff GE Nutrients, Inc.
Correspondence Address	RYAN M KAISER AMIN TALATI LLC 55 W MONROE STREET, SUITE 3400 CHICAGO, IL 60603 UNITED STATES ryan@amintalati.com,saira@amintalati.com,ashley@amintalati.com
Submission	Other Motions/Papers
Filer's Name	Saira J. Alikhan
Filer's e-mail	ryan@amintalati.com, saira@amintalati.com, ashley@amintalati.com
Signature	/s/ Saira J. Alikhan
Date	01/26/2015
Attachments	Motion for Judgment on the Pleadings- Gencor Final.pdf(41254 bytes ) Exhibit A - Full.pdf(167166 bytes ) Exhibit B - Full.pdf(66660 bytes ) Exhibit C - Full.pdf(44739 bytes ) Exhibit D - Full.pdf(116665 bytes ) Exhibit E - Full.pdf(34162 bytes ) Exhibit F - Full.pdf(32754 bytes ) Exhibit G - Full.pdf(80593 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Registration No.: 4,302,581

For the Mark: TESTOGEN-XR

Date Registered: March 12, 2013

GE NUTRIENTS, INC.	)	
	)	
Petitioner,	)	
	)	
V.	)	Petition No. 92059915
	)	
CA IP HOLDINGS, LLC	)	
	)	
Registrant.	)	
	)	
CA IP HOLDINGS, LLC	)	
	)	
Counter-Claimant,	)	
	)	
V.	)	
	)	
GE NUTRIENT, INC.	)	
	)	
Counter-Defendant.	)	
	)	

**PETITIONER/COUNTER-DEFENDANT’S MOTION FOR PARTIAL  
JUDGMENT ON THE PLEADINGS**

Petitioner/Counter-Defendant, GE Nutrients, Inc. (“Counter-Defendant”), by and through its attorneys, AMIN TALATI & UPADHYE, LLC, hereby moves for a partial judgment on the pleadings pursuant to Fed. R. Civ. P. 12(c) and TBMP 5042.127(e) with respect to Registrant/Counter-Claimant, CA IP Holdings, LLC’s (“Counter-Claimant”) Third and Fourth Claims for Cancellation in Registrant’s Answer to Petition for Cancellation, Affirmative Defenses, and Counterclaims to Cancel Petitioner’s

Registration N0. 3,336,267 (“Counterclaims”). As set forth in the attached brief and exhibits, this motion is made on the grounds that as a matter of law, Counter-Defendant did not make a false statement with respect to the registration of its TESTOFEN mark because it had a reasonable belief that its response to the Office Action inquiry from the United States Patent and Trademark Office was true. As such, there is no material issue of fact that remains to be resolved and Counter-Defendant is entitled to partial judgment as a matter of law.

Dated: January 26, 2015

AMIN TALATI & UPADHYE, LLC

/s/ Saira J. Alikhan

Saira J. Alikhan

Ryan M. Kaiser

55 W. Monroe St., Suite 3400

Chicago, IL 60603

saira@amintalati.com

ryan@amintalati.com

312-784-1065 (phone)

312-327-3328 (phone)

Attorneys for Counter-Claimant.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Registration No.: 4,302,581

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GE NUTRIENTS, INC.

Petitioner,

V.

CA IP HOLDINGS, LLC

Registrant.

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CA IP HOLDINGS, LLC

Counter-Claimant,

V.

GE NUTRIENT, INC.

Counter-Defendant.

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Petition No. 92059915

**BRIEF IN SUPPORT OF  
COUNTER-DEFENDANT'S MOTION FOR JUDGMENT ON THE PLEADINGS**

GE Nutrient, Inc. ("Counter-Defendant"), by and through its attorneys, AMIN TALATI UPADHYE, LLC, respectfully submits this Brief in Support of Counter-Defendant's Motion for Judgment on the Pleadings.

## **I. INTRODUCTION**

Counter-Claimant filed six claims for the cancellation of Counter-Defendant's mark TESTOFEN. *See* Registrant's Answer to Petition for Cancellation, Affirmative Defenses, and Counterclaims to Cancel Petitioner's Registration No. 3,336,267 ("Counterclaims"), attached as Exhibit A, *generally*. Counter-Claimant's third and fourth claims for cancellation allege that Counter-Defendant engaged in fraud during the prosecution of its application for registration when it responded to an Office Action issued on January 13, 2006 indicating that the wording "TESTOFEN" did not have any significance in the relevant trade or industry or as applied to the goods/services. *See* Ex. A, pgs. 6 and 9. In its Answer to the counterclaims, Counter-Defendant denied the allegations that it engaged in fraud. *See* Petitioner's Answer to Registrant's Counterclaims to Cancel Petitioner's Registration, attached as Exhibit B.

As articulated below, judgment on the pleadings should be entered with respect to the Counterclaims three and four because, even accepting Counterclaimant's assertions about the significance of the terms "Fen" and Testo" as true, Counter-Defendant's statement in response to the Office Action issued on January 13, 2006 was not false. Because falsity is a required element to Counterclaimant's fraud claims, these claims avail themselves to resolution as a matter of law in Counter-Defendant's favor. Thus, pursuant to Rule 12(c), Fed. R. Civ. P. and Trademark Rule 504, Counter-Defendant seeks a partial judgment on the pleadings and an Order dismissing Counterclaims three and four with prejudice.

## II. UNDISPUTED FACTS

The following facts are admitted for the purposes of this Motion:<sup>1</sup>

1. Counter-Defendant is the owner of U.S. Trademark Registration No. 3,336,267 for TESTOFEN for use in connection with “dietary and nutritional supplements sold and distributed over the counter in class 5.” *See* Ex. A, ¶29 and TESTOFEN Registration Certificate, attached as Exhibit C.
2. Counter-Claimant is the owner of U.S. Trademark Registration No. 4,302,581 for TESTOGEN-XR for use in connection with “dietary supplements for supporting testosterone production, in class 5.” *See* Ex. A, ¶29 and TESTOGEN-XR Registration Certificate, attached as Exhibit D.
3. On January 13, 2006, an Office Action was letter was sent to Counter-Defendant. *See* Ex. A, ¶32 and Office Action for USPTO attached as Exhibit E. The Office Action requested Counter-Defendant (then Applicant) to “indicate whether the wording “**TESTOFEN**” has any significance in the relevant trade or industry as applied to the goods/services. 37 C.F.R. §2.61(b).” *See* Ex. A, ¶ 33 and January 13, 2006 Office Action from USPTO as Exhibit E. (emphasis added).
4. On July 11, 2006, Counter-Defendant responded to the Office Action, stating “the mark TESTOFEN has no significance in the relevant trade or industry or as applied to the goods/services.” *See* Ex. A, ¶ 35 and Response to Office Action attached as Exhibit F.

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<sup>1</sup> The following admissions are made solely in connection with the instant motion and are without prejudice to Counter-Defendant’s rights or defenses at trial, all of which are expressly reserved.

### **III. ARGUMENT**

#### **A. Applicable Legal Standard for Judgment on the Pleadings**

Judgment on the pleadings is a test solely of the undisputed facts appearing in all the pleadings, supplemented by any facts of which the Board will take judicial notice. *Kraft Group LLC v. Harpole*, 90 USPQ2d 1837, 1840 (TTAB 2009). For the purposes of the motion, all well pleaded factual allegations of the nonmoving party must be accepted as true, while those allegations of the moving party which have been denied are deemed false. *Id.* Conclusions of law are not taken as admitted. *Id.* A judgment on the pleadings may be granted only where, on the facts as deemed admitted, there is no genuine issue of material fact to be resolved, and the moving party is entitled to judgment, on the substantive merits of the controversy as a matter of law. *Id.*

In the present proceedings, there are no genuine issues of material fact to be resolved with respect to Counterclaims three and four. Counter-claimant's statement in response to the office action at issue was true. Therefore, as a matter of law, Counter-Defendant did not commit fraud in procuring the registration of the TESTOFEN mark because a required element (*i.e.* a false statement) is missing.

#### **B. Counter-Defendant did not Engage in Fraud in the Procurement of its Registration of the TESTOFEN Mark.**

Counter-Defendant did not engage in fraud in the procurement of the TESTOFEN mark because its response to the Office Action of January 13, 2006 was true. Counterclaimant's allegations are inaccurate and misleading conclusions of law, and judgment should be entered accordingly.

Fraud in procuring a trademark registration occurs when an applicant knowingly makes false, material representations of fact in connection with its application with intent

to deceive the USPTO. *Navistar Mortgage LLC v. Mujahid Ahmad*, TTAB Opp. No. 91177036, pg. 7 citing *In re Bose Corp.*, 580 F.3d 1240, 1245, 91 USPQ 1938, 1941 (Fed. Cir. 2009) and *Swiss Watch Int'l Inc. v. Fed'n of the Swiss Watch Indus.*, 101 USPQ 1731, 1745 (TTAB 2012). A party alleging fraud in the procurement of a registration bears the heavy burden of proving fraud with clear and convincing evidence. *Bose*, 91 USPQ2d at 1243 quoting *Smith v. Int'l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981). A false statement is a required element of a fraud claim.

Counterclaims three and four allege that Counter-Defendant engaged in fraud in the procurement of its TESTOFEN mark because of its representation in response to an Office Action of January 13, 2006 that “the mark ‘TESTOFEN’ has no significance in the relevant trade or industry or as applied to the goods/services.” Counter-Defendant SOF, ¶¶ 3-4. However, Counter-Claimant’s basis for its fraud allegations paints a much different picture and unnecessarily muddies the water with its own conclusions of law. Counterclaims three and four allege that Counter-Defendant engaged in fraud when it responded to the Office Action because it 1) knew “that the term ‘FEN’, was, in fact, significant, as descriptive of the singular ingredient in Petitioner’s goods -- fenugreek extract”, and; 2) believed “that the term TESTO was, in fact, significant, as descriptive of the result of ingestion of Petitioner’s goods -- an increase in testosterone.” Ex. A, ¶¶32-33, 49-60.

Counter-Defendant *never* made a representation that “FEN” or “TESTO” do not have significance in the relevant trade or industry or as applied to the goods/services. (emphasis added).<sup>2</sup> That simply was not the inquiry by the USPTO. Counter-Defendant

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<sup>2</sup> Counter-Defendant disagrees with Counterclaimant’s conclusions of law that TESTO or FEN are descriptive of anything. Nonetheless, that is not the inquiry here.



responded to the inquiry it was presented, which was whether the invented word, **TESTOFEN**, had any significance in the relevant trade or industry as applied to the good/services. (emphasis added). That was the inquiry that Counter-Defendant responded to, and answered truthfully and accurately. Tellingly, Counterclaimant did not and cannot allege that the invented word, TESTOFEN, has any significance in the relevant trade or industry or as applied to the goods/services. That omission is fatal to its claims.

Counterclaimant's attempts to convolute the proceedings are not warranted and do not have a basis in the law. In fact, in an effort to avoid the instant motion, Counter-Defendant (through counsel) twice requested that Counterclaimant provide any case law supporting its third and fourth counterclaims. Email communication from Ryan Kaiser to Scott Smiley on January 14, 2015, attached as Exhibit G. Counterclaimant did not provide any legal support for its seemingly frivolous claims.

Regardless, it is axiomatic that a trademark must be considered as a whole, and one may not "dissect" the mark into isolated elements. *Duopross Meditech Corp., v. Inviro Medical Devices, Ltd.*, 695 F.3d 1247, 1252 (Fed. Cir. 2012) citing *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 545-546, 40 S. Ct. 414, 64 L. Ed. 1920 Dec. Comm'r Pat. 471 (1920). Counterclaims three and four do just that, break up the mark TESTOFEN into two distinctive words "TESTO" and "FEN," in contravention of the anti-dissection rule. Indeed, Counterclaimant's own trademark application contradicts its theory here. Counterclaimant applied for the mark TESTOGEN-XR for a product that helps generate testosterone. By Counterclaimant's own position, TESTOGEN-XR should be deemed descriptive because "TESTO" and "GEN" are

descriptive of the result of ingestion of [its] goods – an increase in testosterone. That is not the law, and as such, judgment on the pleadings should be entered for Counterclaims three and four.

#### **IV. CONCLUSION**

Because Counter-Defendant did not make a false statement in the procurement of its registration when it answered the inquiry presented in the Office Action of January 13, 2006, Counterclaims three and four should be dismissed with prejudice from Counter-Claimant's cancellation proceeding.

WHEREFORE, Counter-Defendant prays that this Honorable Board enter judgment on the pleadings with respect to Counterclaims three and four and dismiss them with prejudice, or for such further relief as this Board deems reasonable and just.

Dated: January 26, 2015

AMIN TALATI & UPADHYE, LLC

/s/Saira J. Alikhan  
Saira J. Alikhan  
Ryan M. Kaiser  
55 W. Monroe Street  
Suite 3400  
Chicago, IL 60603  
ryan@amintalati.com  
saira@amintalati.com  
312-784-1065 (phone)  
312-884-7352 (fax)

Attorneys for Counter-Defendant.

### **PROOF OF SERVICE**

I am over the age of 18 and not a party to the within action; my business address is Amin Talati, LLC, 55 W. Monroe Street, Suite 3400, Chicago, IL 60603. On **January 26, 2015**, a copy of the attached **MOTION FOR PARTIAL JUDGMENT ON THE PLEADINGS** was served on all interested parties in this action via email (by agreement) and U.S. Mail, FedEx or the equivalent, postage prepaid, at the addresses as follows:

To: Scott D. Smiley  
The Concept Law Group, P.A.  
Museum Plaza  
200 South Andrews Avenue  
Suite 100  
Fort Lauderdale, FL 33301

Executed on **January 26, 2015**, at Chicago, Illinois. I declare under penalty of perjury that the above is true and correct. I declare that I am employed in the office of Amin Talati, LLC at whose direction service was made.

/s/ Saira J. Alikhan  
Saira J. Alikhan

### **CERTIFICATE OF TRANSMISSION**

I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office using the ESTTA system on **January 26, 2015**.

/s/ Saira J. Alikhan  
Saira J. Alikhan

# Exhibit A

ESTTA Tracking number: **ESTTA633929**

Filing date: **10/20/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92059915
Party	Defendant CA IP Holdings, LLC
Correspondence Address	CA IP HOLDINGS LLC 2041 HIGH RIDGE ROAD, SUITE B BOYNTON BEACH, FL 33426 UNITED STATES
Submission	Answer and Counterclaim
Filer's Name	Scott D. Smiley
Filer's e-mail	Scott@ConceptLaw.com, Info@ConceptLaw.com, YJun@ConceptLaw.com
Signature	/Scott D. Smiley/
Date	10/20/2014
Attachments	Cancellation 92059915 - Answer to Petition to Cancel - FINAL.pdf(166537 bytes )

Registration Subject to the filing

Registration No	3336267	Registration date	11/13/2007
Registrant	GE NUTRIENTS, INC. 19700 Fairchild Road Irvine, CA 92612 UNITED STATES		
Grounds for filing	The registered mark has been abandoned.		
	The registration was obtained fraudulently.		

Goods/Services Subject to the filing

Class 005. First Use: 2005/06/30 First Use In Commerce: 2005/06/30  
All goods and services in the class are requested, namely: dietary supplements sold and distributed over the counter

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

GE Nutrients, Inc.,  
Petitioner

v.

CA IP Holdings, LLC,  
Registrant

Cancellation No. 92059915  
Registration No. 4,302,581  
Mark: TESTOGEN-XR

**REGISTRANT’S ANSWER TO PETITION FOR CANCELLATION, AFFIRMATIVE  
DEFENSES, AND COUNTERCLAIMS TO CANCEL PETITIONER’S REGISTRATION  
NO. 3,336,267**

CA IP Holdings, LLC. (“Registrant”), by and through undersigned counsel, hereby submits this Answer in response to the Petition for Cancellation filed in this matter by GE Nutrients, Inc. (“Petitioner”). Unless specifically admitted below, Registrant denies each and every allegation in the Petition for Cancellation. Registrant further answers the numbered paragraphs in the Petition for Cancellation as follows:

1. Registrant is without knowledge or information sufficient to form a belief as to the allegations of Paragraph 1 of the Petition for Cancellation and therefore denies those allegations.

2. Registrant is without knowledge or information sufficient to form a belief as to the allegations of Paragraph 2 of the Petition for Cancellation and therefore denies those allegations.

3. Registrant is without knowledge or information sufficient to form a belief as to the allegations of Paragraph 3 of the Petition for Cancellation and therefore denies those allegations.

4. Registrant admits the allegations of Paragraph 4 of the Petition for Cancellation.

5. With respect to the "claimed first date of use" in the first sentence of Paragraph 5 of the Petition for Cancellation, due to the ambiguity as to whether Petitioner is inquiring about first date of use anywhere or first date of use in interstate commerce, Registrant is without knowledge or information sufficient to form a belief as to the truth or falsity thereof. To the extent an answer is required, Registrant admits the allegations. With respect to the "earliest date upon which Registrant can rely for purposes of determining priority of use" in the second sentence of Paragraph 5 of the Petition for Cancellation, Registrant responds that this sentence calls for a legal conclusion, requiring no answer. To the extent an answer is required, Registrant admits the allegations.

6. Registrant is without knowledge or information sufficient to form a belief as to the allegations of Paragraph 6 of the Petition for Cancellation and therefore denies those allegations.

7. Registrant denies the allegations of Paragraph 7 of the Petition for Cancellation.

### **AFFIRMATIVE DEFENSES**

#### **First Affirmative Defense (Laches)**

8. Registrant began using the TESTOGEN-XR mark in 2011 by promoting dietary supplements for supporting testosterone production. Registrant invested and continues to invest large amounts of time and monetary resources towards promoting and selling said dietary supplements throughout the United States in connection with the mark TESTOGEN-XR.

9. Registrant applied for registration of the mark TESTOGEN-XR on January 26, 2012.

10. The mark TESTOGEN-XR was published in the Official Gazette on June 19, 2012, giving any person who believed he/she would be damaged an opportunity to oppose the mark, prior to the mark receiving a registration.

11. Upon information and belief, Petitioner possessed knowledge (or should have known) of Registrant's trademark application and failed to oppose the mark, either before the Trademark Trial and Appeals Board (TTAB) or through any direct correspondence with Registrant.

12. Registrant received Registration No. 4,302,581 from the United States Patent and Trademark Office (USPTO) on March 12, 2013. Thereafter, Registrant continued to promote and sell dietary supplements in connection with the mark TESTOGEN-XR, investing large amounts of time and monetary resources towards promoting the mark and creating good will in its consumers.

13. Upon information and belief, Petitioner possessed knowledge (or should have known) of Registrant's use of the mark TESTOGEN-XR in connection with dietary supplements for supporting testosterone production prior to and on March 12, 2013, the date of registration of the Registrant's mark TESTOGEN-XR.

14. Petitioner waited until September 9, 2014, to file the Petition for Cancellation (Cancellation No. 92059915), approximately 18 months after Registrant received its registration. During this time, Registrant made a considerable investment creating good will in its consumers for the mark TESTOGEN-XR in connection with dietary supplements for promoting testosterone production. Petitioner's delay in taking any action prior to September 9, 2014 is inexcusable.

15. Petitioner's inexcusable delay resulted in Registrant's detrimental reliance. In reliance on Petitioner's silence and inaction, Registrant built up a valuable business and good will around the mark TESTOGEN-XR.

16. Based on the doctrine of laches, Petitioner should be barred from benefiting from Petitioner's own inexcusable delay, which resulted in detrimental reliance by the Registrant.

### **Second Affirmative Defense (Estoppel)**

17. Registrant repeats and realleges, as if fully set forth herein, each and every allegation contained in the foregoing paragraphs.



18. Upon information and belief, Petitioner possessed knowledge (or should have known) of Registrant's trademark application for the mark TESTOGEN-XR, published in the Official Gazette on Jun 19, 2012, and failed to oppose the mark, either before the Trademark Trial and Appeals Board (TTAB) or through any direct correspondence with Registrant.

19. After Registrant received its registration from the USPTO on March 12, 2013, Registrant continued to promote and sell dietary supplements in connection with the mark TESTOGEN-XR, investing large amounts of time and monetary resources towards promoting the mark and creating good will in its consumers.

20. Upon information and belief, Petitioner possessed knowledge (or should have known) of Registrant's use of the mark TESTOGEN-XR in connection with dietary supplements for supporting testosterone production prior to and on March 12, 2013, the date of registration of the Registrant's mark TESTOGEN-XR.

21. Petitioner waited until September 9, 2014, to file the Petition for Cancellation (Cancellation No. 92059915), approximately 18 months after Registrant received its registration. During this time, Registrant made a considerable investment creating good will in its consumers for the mark TESTOGEN-XR in connection with dietary supplements for promoting testosterone. Petitioner's silence and inaction lead Registrant to reasonably infer that Petitioner would not assert any action against Registrant's use and registration of the TESTOGEN-XR mark in connection with dietary supplements for testosterone production.

22. Due to this reliance, Registrant built up a valuable business and good will around the mark TESTOGEN-XR, which would result in material prejudice to Registrant if the delayed assertion by the Petitioner is permitted.

23. Based on the doctrine of equitable estoppel, Petitioner should be estopped from benefiting from Petitioner's own unreasonable delay, which would result in material prejudice to Registrant.

24. Registrant reserves its right to amend the above affirmative defenses during the term of this proceeding and through evidence and information acquired during discovery.

**COUNTERCLAIMS TO**  
**CANCEL PETITIONER'S REGISTRATION NO. 3,336,267**

**BACKGROUND**

25. Registrant repeats and realleges, as if fully set forth herein, each and every allegation contained in the foregoing paragraphs.

26. Registrant is engaged in a successful business, selling dietary supplements for testosterone production.

27. Registrant has invested a great deal of time and money in promoting Registrant's business, and is continuing to spend substantial amounts of time and money in the promotion of the same.

28. On January 26, 2012, Registrant applied for the registration of TESTOGEN-XR on the Principal Register for "dietary supplements for testosterone production." On March 12, 2013, Registrant received a registration from the USPTO for the same.

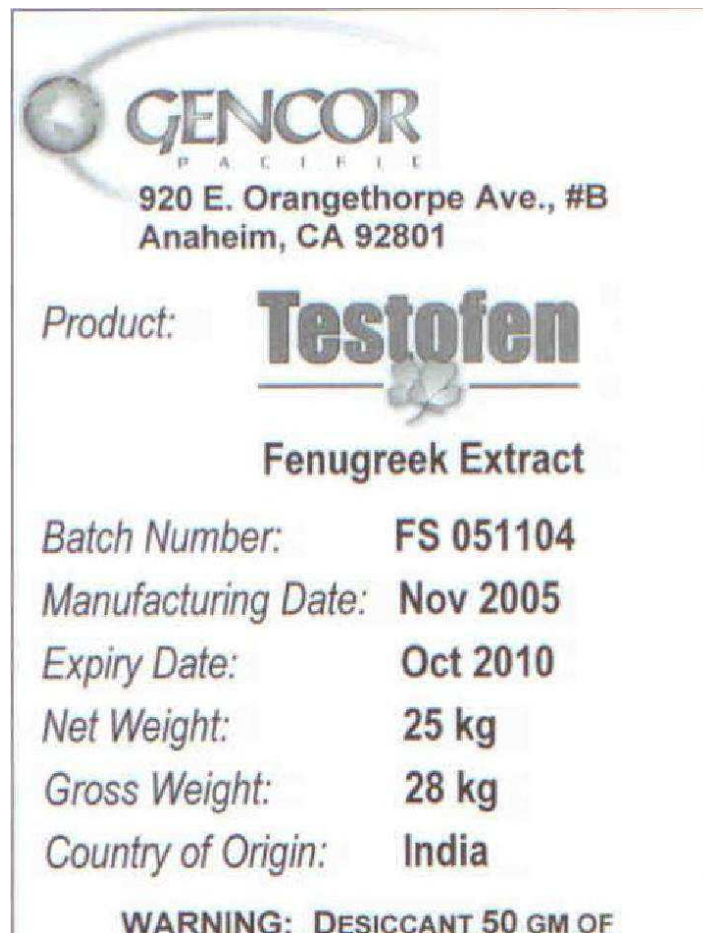
29. On June 22, 2005, Petitioner applied for registration of TESTOFEN, under 15 U.S.C. § 1051(b), on the Principal Register for "dietary supplements."

30. On June 22, 2005, Petitioner submitted a sworn declaration to the USPTO that Petitioner possessed "a bona fide intention to use the mark in commerce on or in connection with the identified goods," which identified goods were, at said date, "dietary supplements" in international class 005.

31. On June 22, 2005, Petitioner submitted a sworn declaration to the USPTO in which it was declared under oath that "willful false statements, and the like, may jeopardize the validity of the application or any resulting registration...and that all statements made of his/her own knowledge are true."

32. On January 13, 2006, the USPTO issued an Office Action in connection with Petitioner's application, requiring that Petitioner "indicate whether the wording 'TESTOFEN' has any significance in the relevant trade or industry or as applied to the goods/services."

33. In response, on July 11, 2006, Petitioner responded that the "mark TESTOFEN has no significance in the relevant trade or industry or as applied to the goods/services." Upon information and belief, Petitioner made a false representation to the USPTO, knowing that the term FEN was, in fact, significant, as descriptive of the singular ingredient in Petitioner's goods: fenugreek extract. In fact, Petitioner's specimen of use, reproduced herein below, filed with the U.S. Trademark Office on August 13, 2007, clearly demonstrates that Petitioner's goods are fenugreek extract.



34.

35. In response to the January 13, 2006 Office Action, on July 11, 2006, Petitioner responded that the "mark TESTOFEN has no significance in the relevant trade or industry or as

applied to the goods/services.” Upon information and belief, Petitioner made a false representation to the USPTO, believing that the term TESTO was, in fact, significant, as descriptive of the result of ingestion of Petitioner’s goods: an increase in testosterone.

36. On November 20, 2006, Registrant filed an amendment to the identification of the goods from “dietary supplements” to “dietary supplements SOLD AND DISTRIBUTED OVER THE COUNTER.” The term “over the counter” is well known by those in the industry to indicate products available to the general public without prescription. Upon information and belief, Petitioner made a false representation to the USPTO that the Petitioner possessed a bona fide intention to use the mark TESTOFEN in connection with dietary supplements sold and distributed “over the counter,” i.e., to the general public, when, in fact, Petitioner’s intent was to sell fenugreek extract in bulk as an ingredient to chemical compounders, who combine various ingredients into a formula, rather than over the counter. Upon information and belief, Petitioner’s use of the mark TESTOFEN, has, until very recently, been restricted to the sale of fenugreek extract as an ingredient to chemical compounders and not to the general public.

37. On August 13, 2007, Petitioner filed a Statement of Use stating that the mark TESTOFEN was first used as early as June 30, 2005 as a “dietary supplements sold and distributed over the counter.” Further, within the Statement of Use, Petitioner submitted a sworn declaration to the USPTO that Petitioner was warned that “willful false statements and the like may jeopardize the validity of” the application. Upon information and belief, Petitioner made a false statement to the USPTO, knowing that Petitioner’s use was restricted to selling fenugreek extract as an ingredient to chemical compounders, as opposed to “over the counter,” i.e., the general public.

38. On May 16, 2013, Petitioner filed a Combined Declaration of Use and Incontestability under Sections 8 & 15 declaring that “the mark is in use in commerce on or in connection with all of the goods or services listed in the existing registration for this specific class: dietary supplements sold and distributed over the counter; and the mark has been continuously used in commerce for five (5) consecutive years after the date of registration...and is still in use in commerce on or in connection with all goods or services listed in the existing registration for this class.” Upon information and belief, Petitioner made a false statement to the

USPTO, knowing that Petitioner's use was restricted to selling fenugreek extract as an ingredient to chemical compounds, rather than "over the counter," i.e., to the general public. Upon information and belief, on or before May 16, 2013, when the Section 8 & 15 declarations were filed, Petitioner had, in fact, not sold any dietary supplements over the counter using the mark TESTOFEN.

**FIRST CLAIM FOR CANCELLATION:  
VOID AB INITIO**

39. Registrant repeats and realleges, as if fully set forth herein, each and every allegation contained in the foregoing paragraphs.

40. Registrant expressly alleges that Registrant's standing is based on its position as defendant in the present cancellation.

41. Upon information and belief, Petitioner's statement of use of the mark TESTOFEN in commerce for the identified goods, namely dietary supplements sold and distributed over the counter, at the time of filing of Petitioner's application was false, and therefore Registration No. 3,336,267 should be considered void ab initio, invalid from the start.

**SECOND CLAIM FOR CANCELLATION:  
FRAUD IN THE PROCUREMENT OF ITS REGISTRATION**

42. Registrant repeats and realleges, as if fully set forth herein, each and every allegation contained in the foregoing paragraphs.

43. Petitioner made false representations: 1) on June 22, 2005, regarding its bona fide intent to use the mark TESTOFEN on dietary supplements; 2) on August 13, 2007, in its Statement of Use alleging use in commerce on dietary supplements sold and distributed over the counter; and 3) On May 16, 2013, in its Section 8 and 15 declarations alleging continuous use in commerce on all of the goods listed in the registration.

44. Petitioner's false representations are material to registrability, because the registration certificate falsely indicates to the public that the goods that are protected by the registration are dietary supplements sold and distributed over the counter, when in fact the

Petitioner had only been using the mark TESTOFEN on fenugreek extract, as an ingredient for sale to chemical compounders.

45. Upon information and belief, Petitioner had knowledge of the falsity of the representation because Petitioner specifically requested that the USPTO amend the identification of goods to include “OVER THE COUNTER.” Yet, upon information and belief, Petitioner knew or should have known that its use and intent to use was restricted to the sale of fenugreek extract as an ingredient to chemical compounders and not the general public.

46. Upon information and belief, Petitioner’s false representations were made in bad faith and with intent to deceive the USPTO.

47. Petitioner’s false representations have injured Registrant by, among other things, providing Petitioner standing to institute the instant Petition for Cancellation, thereby causing Petitioner the expense of responding.

48. Upon information and belief, the conduct of Petitioner constitutes fraud on the USPTO and injures Registrant and the purchasing public. Therefore, Registration No. 3,336,267 should be cancelled.

**THIRD CLAIM FOR CANCELLATION: FRAUD DURING  
THE PROSECUTION OF ITS APPLICATION FOR REGISTRATION**

49. Registrant repeats and realleges, as if fully set forth herein, each and every allegation contained in the foregoing paragraphs.

50. During prosecution of its application for registration, Petitioner represented that TESTOFEN “has no significance in the relevant trade or industry or as applied to the goods/services.” Upon information and belief, said representation by Petitioner was false because Petitioner knew that FEN was descriptive of the single ingredient in Petitioner’s goods—fenugreek extract.

51. Upon information and belief, said false representation is material to registrability because the USPTO would likely have issued a rejection of Petitioner’s application as being merely descriptive of the goods.

52. Upon information and belief, Petitioner's false representation was made in bad faith and with intent to deceive the USPTO.

53. Petitioner's false representations have injured Registrant by, among other things, providing Petitioner standing to institute the instant Petition for Cancellation, thereby causing Petitioner the expense of responding.

54. Upon information and belief, the conduct of Petitioner constitutes fraud on the USPTO and injures Registrant and the purchasing public. Therefore, Registration No. 3,336,267 should be cancelled.

**FOURTH CLAIM FOR CANCELLATION: FRAUD DURING  
THE PROSECUTION OF ITS APPLICATION FOR REGISTRATION**

55. Registrant repeats and realleges, as if fully set forth herein, each and every allegation contained in the foregoing paragraphs.

56. During prosecution of its application for registration, Petitioner represented that TESTOFEN "has no significance in the relevant trade or industry or as applied to the goods/services." Upon information and belief, said representation by Petitioner was false because Petitioner believed that TESTO was descriptive of the result of ingestion of Petitioner's goods—an increase in testosterone.

57. Upon information and belief, said false representation is material to registrability because the USPTO would likely have issued a rejection of Petitioner's application as being merely descriptive of the goods.

58. Upon information and belief, Petitioner's false representation was made in bad faith and with intent to deceive the USPTO.

59. Petitioner's false representations have injured Registrant by, among other things, providing Petitioner standing to institute the instant Petition for Cancellation, thereby causing Petitioner the expense of responding.

60. Upon information and belief, the conduct of Petitioner constitutes fraud on the USPTO and injures Registrant and the purchasing public. Therefore, Registration No. 3,336,267 should be cancelled.

**FIFTH CLAIM FOR CANCELLATION:  
ABANDONMENT DUE TO NONUSE**

61. Registrant repeats and realleges, as if fully set forth herein, each and every allegation contained in the foregoing paragraphs.

62. Upon information and belief, Petitioner did not use the mark TESTOFEN on dietary supplements sold and distributed over the counter for at least three consecutive years since the issuance of Petitioner's registration. Therefore, Petitioner abandoned its registration due to nonuse.

**SIXTH CLAIM FOR CANCELLATION:  
PARTIAL CANCELLATION UNDER THE TRADEMARK  
ACT § 18, 15 U.S.C. § 1068, FOR ABANDONMENT**

63. Registrant repeats and realleges, as if fully set forth herein, each and every allegation contained in the foregoing paragraphs.

64. Upon information and belief, Petitioner did not use the mark TESTOFEN on dietary supplements sold and distributed over the counter for at least three consecutive years since the issuance of Petitioner's registration.

65. Registrant requests, in conformance with 15 U.S.C. § 1068, a partial cancellation of Registration No. 3,336,267, deleting the identification of goods with respect "dietary supplements sold and distributed over the counter" and adding the identification "fenugreek extract sold and distributed to chemical compounds," or other like identification that truthfully and accurately reflects Petitioner's original use of the corresponding goods. Said partial cancellation would avoid any alleged likelihood of consumer confusion, as the Petitioner's and Registrant's goods would be offered in different channels of trade. Additionally, Petitioner's consumers would not be likely to be confused due to their sophistication.



WHEREFORE, Registrant denies that Petitioner is entitled to any relief and requests that the Board dismiss the Petitioner's Petition for Cancellation filed in this proceeding. Registrant prays Registration No. 3,336,267 be cancelled, or alternatively, that Registration No. 3,336,267 be partially cancelled.

Dated: October 20, 2014

Respectfully submitted,

The Concept Law Group, P.A.

By: /Scott D. Smiley/  
Scott D. Smiley  
Museum Plaza  
200 South Andrews Avenue  
Suite 100  
Fort Lauderdale, FL 33301  
(754) 300-1500

Attorney for Registrant,  
CA IP Holdings, LLC

Certificate of Mailing and Service

I certify that on October 20, 2014, the foregoing ANSWER TO PETITION TO CANCEL AND COUNTERCLAIM is being served by mailing a copy thereof by U.S. mail and email to:

Ryan M. Kaiser  
Saira J. Alikhan  
Amin Talati LLC  
55 W. Monroe Street,  
Suite 3400  
Chicago, IL 60603  
Telephone: (312) 327-3328  
Facsimile: (312) 884-7352  
ryan@amintalati.com  
saira@amintalati.com

By: /Scott D. Smiley/  
Scott D. Smiley  
Museum Plaza  
200 South Andrews Avenue  
Suite 100  
Fort Lauderdale, FL 33301  
(754) 300-1500

Attorney for Registrant,  
CA IP Holdings, LLC

## Exhibit B

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Registration No.: 4,302,581

For the Mark: TESTOGEN-XR

Date Registered: March 12, 2013

GE NUTRIENTS, INC.	)	
	)	
Petitioner,	)	
	)	
V.	)	Petition No. 92059915
	)	
CA IP HOLDINGS, LLC	)	
	)	
Registrant.	)	
	)	

**PETITIONER'S ANSWER TO REGISTRANT'S COUNTERCLAIMS TO CANCEL  
PETITIONER'S REGISTRATION**

GE Nutrients, Inc. ("Petitioner" and "Counter-defendant"), by and through its undersigned counsel, hereby submits this Answer in response to CA IP Holding's, LLC ("Registrant" and Counterclaimant) Counterclaims to Cancel Petitioner's Registration as follows:

25. Petitioner is unable to make an answer to Paragraph 25 of the Counterclaims to Cancel because it is simply a re-allegation of every allegation contained in the foregoing paragraphs which were answers to the Petition to Cancel and Registrant's Counterclaims. To the extent an answer is required, Petitioner is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 25 of Registrants' Counterclaims to Cancel.

26. Petitioner is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 26 of Registrant's Counterclaims to Cancel.

27. Petitioner is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 27 of Registrant's Counterclaims to Cancel.

28. Petitioner is without knowledge or information sufficient to form a belief as to the truth of the allegations in contained in Paragraph 28 of Registrant's Counterclaims to Cancel.

29. Petitioner admits the allegations contained in Paragraph 29 of Registrant's Counterclaims to Cancel.

30. Petitioner admits the allegations contained in Paragraph 30 of Registrant's Counterclaims to Cancel.

31. Petitioner admits the allegations contained in Paragraph 31 of Registrant's Counterclaims to Cancel.

32. Petitioner admits the allegations contained in Paragraph 32 of Registrant's Counterclaims to Cancel.

33. Petitioner admits it responded to the USPTO Office Action on July 11, 2006 and stated that "the mark TESTOFEN has no significance in the relevant trade or industry or as applied to the goods/services." Petitioner admits that it submitted a specimen of use to the USPTO on August 13, 2007. Petitioner denies the remaining allegations contained in Paragraph 33.

34. Petitioner is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 34 of Registrant's Counterclaims to Cancel because it contains no allegations and only an image. To the extent that an answer is required, Petitioner

admits that the image contained in paragraph 34 is the specimen it submitted to the USPTO on August 13, 2007.

35. Petitioner admits that in response to the January 13, 2006 Office Action, it responded that the “mark TESTOFEN has no significance in the relevant trade or industry or as applied to the goods/services.” Petitioner denies the remaining allegations contained in Paragraph 35.

36. Petitioner admits that on November, 22, 2006 it filed an amendment to the identification of the goods from “dietary supplements” to “dietary supplements sold and distributed over the counter in class 5.” Petitioner denies the remaining allegations contained in Paragraph 36.

37. Petitioner admits that on August 13, 2007, it filed a Statement of Use stating that the mark TESTOFEN was first used as early as June 30, 2005, as “dietary supplements sold and distributed over the counter.” Petitioner admits that within the Statement of Use, Petitioner submitted a sworn declaration to the USPTO that Petitioner was warned that “willful false statements and the like are punishable by fine or imprisonment, or both under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of this document, and declared that he/she is properly authorized to execute this document on behalf of the Owner; and all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.” Petitioner denies the remaining allegations contained in Paragraph 37.

38. Petitioner admits that on May 16, 2013, it filed a Combined Declaration of Use and Incontestability under Sections 8 & 15 declaring that “the mark is in use in commerce on or

in connection with all of the goods or services listed in the existing registration for this specific class: dietary supplements sold and distributed over the counter; and the mark has been continuously used in commerce for five (5) consecutive years after the date of registration....and is still in use in commerce on or in connection with all goods or services listed in the existing registration for this class.” Petitioner denies the remaining allegations contained in Paragraph 38.

39. Petitioner repeats and realleges, as if fully set forth herein, each and every answer to the allegations contained in the foregoing paragraphs.

40. Petitioner is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 40 of Registrant’s Counterclaims to Cancel.

41. Petitioner denies the allegations contained in Paragraph 41 of Registrant’s Counterclaims to Cancel.

42. Petitioner repeats and realleges, as if fully set forth herein, each and every answer to the allegations contained in the foregoing paragraphs.

43. Petitioner denies the allegations contained in Paragraph 43 of Registrant’s Counterclaims to Cancel.

44. Petitioner denies the allegations contained in Paragraph 44 of Registrant’s Counterclaims to Cancel.

45. Petitioner denies the allegations contained in Paragraph 45 of Registrant’s Counterclaims to Cancel.

46. Petitioner denies the allegations contained in Paragraph 46 of Registrant's Counterclaims to Cancel.

47. Petitioner denies the allegations contained in Paragraph 47 of Registrant's Counterclaims to Cancel.

48. Petitioner denies the allegations contained in Paragraph 48 of Registrant's Counterclaims to Cancel.

49. Petitioner repeats and realleges, as if fully set forth herein, each and every answer to the allegations contained in the foregoing paragraphs.

50. Petitioner admits that it represented that TESTOFEN "has no significance in the relevant trade or industry or as applied to the goods/services." Petitioner denies the remaining allegations contained in Paragraph 50 of Registrant's Counterclaims to Cancel.

51. Petitioner denies the allegations contained in Paragraph 51 of Registrant's Counterclaims to Cancel.

52. Petitioner denies the allegations contained in Paragraph 52 of Registrant's Counterclaims to Cancel.

53. Petitioner denies the allegations contained in Paragraph 53 of Registrant's Counterclaims to Cancel.

54. Petitioner denies the allegations contained in Paragraph 54 of Registrant's Counterclaims to Cancel.



55. Petitioner repeats and realleges, as if fully set forth herein, each and every answer to the allegations contained in the foregoing paragraphs.

56. Petitioner admits that it represented that TESTOFEN “has no significance in the relevant trade or industry or as applied to the goods/services.” Petitioner denies the remaining allegations contained in Paragraph 56 of Registrant’s Counterclaims to Cancel.

57. Petitioner denies the allegations contained in Paragraph 57 of Registrant’s Counterclaims to Cancel.

58. Petitioner denies the allegations contained in Paragraph 58 of Registrant’s Counterclaims to Cancel.

59. Petitioner denies the allegations contained in Paragraph 59 of Registrant’s Counterclaims to Cancel.

60. Petitioner denies the allegations contained in Paragraph 60 of Registrant’s Counterclaims to Cancel.

61. Petitioner repeats and realleges, as if fully set forth herein, each and every answer to the allegations contained in the foregoing paragraphs.

62. Petitioner denies the allegations contained in Paragraph 62 of Registrant’s Counterclaims to Cancel.

63. Petitioner repeats and realleges, as if fully set forth herein, each and every answer to the allegations contained in the foregoing paragraphs.

64. Petitioner denies the allegations contained in Paragraph 64 of Registrant's Counterclaims to Cancel.

65. Petitioner denies that Registrant is entitled to this relief, or any relief thereof, and denies the allegations therein.

WHEREFORE, Petitioner denies that Registrant is entitled to any relief and requests that the Board dismiss the Registrant's Counterclaim to Cancel Petitioner's Registration.

Dated: December 5, 2014

Respectfully submitted:

/s/ Ryan M. Kaiser  
Ryan M. Kaiser  
Saira J. Alikhan  
AMIN TALATI, LLC  
55 W. Monroe St.  
Suite 3400  
Chicago, Illinois 60603  
Telephone: (312) 327-3328  
Facsimile: (312) 884-7352  
ryan@amintalati.com  
saira@amintalati.com

Attorneys for Petitioner

**CERTIFICATE OF SERVICE**

I hereby certify that on this 5th day of December 2014, the forgoing **Petitioner's Answer to Registrant's Counterclaim to Cancel Petitioner's Registration** was served, by mailing same by US First Class mail, on the following correspondent as set forth in the records of the U.S. Patent and Trademark Office:

Scott D. Smiley  
The Concept Law Group, P.A.  
Museum Plaza  
200 South Andrews Avenue, Suite 100  
Fort Lauderdale, FL 33301

CA IP Holdings, LLC  
2041 High Ridge Road  
Suite B  
Boynton Beach, Florida 33426

/s/ Saira J. Alikhan

Saira J. Alikhan

**CERTIFICATE OF TRANSMISSION**

I, Saira J. Alikhan, hereby certify that the forgoing **Petitioner's Answer to Registrant's Counterclaims to Cancel Petitioner's Registration** is being electronically transmitted to the United States Patent and Trademark Office today, December 5, 2014.

Dated: December 5, 2014

/s/ Saira J. Alikhan  
Saira J. Alikhan

## Exhibit C

**Int. Cl.: 5**

**Prior U.S. Cls.: 6, 18, 44, 46, 51, and 52**

**United States Patent and Trademark Office**

**Reg. No. 3,336,267**

**Registered Nov. 13, 2007**

**TRADEMARK  
PRINCIPAL REGISTER**

**Testofen**

GENCOR PACIFIC, INC. (VIRGINIA CORPORATION)  
5721 BAYSIDE ROAD, SUITE B  
VIRGINA BEACH, VA 23455

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

FOR: DIETARY SUPPLEMENTS SOLD AND DISTRIBUTED OVER THE COUNTER, IN CLASS 5 (U.S. CLS. 6, 18, 44, 46, 51 AND 52).

SN 78-655,800, FILED 6-22-2005.

FIRST USE 6-30-2005; IN COMMERCE 6-30-2005.

PRISCILLA MILTON, EXAMINING ATTORNEY

## Exhibit D

# United States of America

United States Patent and Trademark Office

## TESTOGEN-XR

**Reg. No. 4,302,581**

**Registered Mar. 12, 2013**

**Int. Cl.: 5**

**TRADEMARK**

**PRINCIPAL REGISTER**

ANE MARKETERS AND MANAGEMENT, LLC (FLORIDA LIMITED LIABILITY COMPANY)  
2041 HIGH RIDGE RD  
BOYNTON BEACH, FL 33426

FOR: DIETARY SUPPLEMENTS FOR SUPPORTING TESTOSTERONE PRODUCTION, IN  
CLASS 5 (U.S. CLS. 6, 18, 44, 46, 51 AND 52).

FIRST USE 8-1-2011; IN COMMERCE 10-1-2011.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SN 85-526,031, FILED 1-26-2012.

SHAUNIA CARLYLE, EXAMINING ATTORNEY



*Lea Street Lee*

Acting Director of the United States Patent and Trademark Office



**REQUIREMENTS TO MAINTAIN YOUR FEDERAL  
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE  
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

**Requirements in the First Ten Years\***

**What and When to File:**

**First Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. *See* 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

**Second Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.\*  
*See* 15 U.S.C. §1059.

**Requirements in Successive Ten-Year Periods\***

**What and When to File:**

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.\*

**Grace Period Filings\***

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or  
reminder of these filing requirements.**

**\*ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the USPTO. The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. *See* 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. *See* 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

**NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.**

# Exhibit E

# UNITED STATES PATENT AND TRADEMARK OFFICE

**SERIAL NO:** 78/655800

**APPLICANT:** Gencor Pacific, Inc.

**\*78655800\***

**CORRESPONDENT ADDRESS:**

RAKESH M. AMIN  
AMIN LAW, LLC  
217 N JEFFERSON ST STE 500  
CHICAGO, IL 60661-1143

**RETURN ADDRESS:**

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**MARK:** TESTOFEN

**CORRESPONDENT'S REFERENCE/DOCKET NO :** N/A

**CORRESPONDENT EMAIL ADDRESS:**

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

## OFFICE ACTION

**RESPONSE TIME LIMIT:** TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-MAILING DATE.

**MAILING/E-MAILING DATE INFORMATION:** If the mailing or e-mailing date of this Office action does not appear above, this information can be obtained by visiting the USPTO website at <http://tarr.uspto.gov/>, inserting the application serial number, and viewing the prosecution history for the mailing date of the most recently issued Office communication.

Serial Number 78/655800

The assigned examining attorney has reviewed the referenced application and determined the following.

### **Search Results**

The examining attorney has searched the Office records and has found no similar registered or pending mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02.

### **Significance of Mark**

The applicant must indicate whether the wording "TESTOFEN" has any significance in the relevant trade

or industry or as applied to the goods/services. 37 C.F.R. §2.61(b).

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.

/Priscilla Milton/  
Examining Attorney  
Law Office 110  
(571) 272-9199

**HOW TO RESPOND TO THIS OFFICE ACTION:**

- **ONLINE RESPONSE:** You may respond formally using the Office's Trademark Electronic Application System (TEAS) Response to Office Action form (visit <http://www.uspto.gov/teas/index.html> and follow the instructions, but if the Office Action has been issued via email, you must wait 72 hours after receipt of the Office Action to respond via TEAS).
- **REGULAR MAIL RESPONSE:** To respond by regular mail, your response should be sent to the mailing return address above and include the serial number, law office number and examining attorney's name in your response.

**STATUS OF APPLICATION:** To check the status of your application, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov>.

**VIEW APPLICATION DOCUMENTS ONLINE:** Documents in the electronic file for pending applications can be viewed and downloaded online at <http://portal.uspto.gov/external/portal/tow>.

**GENERAL TRADEMARK INFORMATION:** For general information about trademarks, please visit the Office's website at <http://www.uspto.gov/main/trademarks.htm>

**FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY SPECIFIED ABOVE.**

# Exhibit E

## Response to Office Action

The table below presents the data as entered.

Input Field	Entered
<b>SERIAL NUMBER</b>	78655800
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 110
<b>MARK SECTION (no change)</b>	
<b>ADDITIONAL STATEMENTS SECTION</b>	
MISCELLANEOUS STATEMENT	The mark TESTOFEN has no significance in the relevant trade or industry or as applied to the goods/services.
<b>SIGNATURE SECTION</b>	
RESPONSE SIGNATURE	/Rakesh M. Amin/
SIGNATORY NAME	Rakesh M. Amin
SIGNATORY POSITION	Attorney for Applicant
SIGNATURE DATE	07/11/2006
<b>FILING INFORMATION SECTION</b>	
SUBMIT DATE	Tue Jul 11 19:48:43 EDT 2006
TEAS STAMP	USPTO/ROA-67.38.223.52-20 060711194843484388-786558 00-33228d2e485d6d17ed85e9 ac82cd6357-N/A-N/A-200607 11194151149726

**Response to Office Action**  
**To the Commissioner for Trademarks:**

Application serial no. **78655800** has been amended as follows:

**Additional Statements**

The mark TESTOFEN has no significance in the relevant trade or industry or as applied to the goods/services.

**Response Signature**

Signature: /Rakesh M. Amin/ Date: 07/11/2006

Signatory's Name: Rakesh M. Amin

Signatory's Position: Attorney for Applicant

Serial Number: 78655800

Internet Transmission Date: Tue Jul 11 19:48:43 EDT 2006

TEAS Stamp: USPTO/ROA-67.38.223.52-20060711194843484

388-78655800-33228d2e485d6d17ed85e9ac82c

d6357-N/A-N/A-20060711194151149726

# Exhibit G



**From:** [Ryan Kaiser](#)  
**To:** [Scott Smiley \(scott@conceptlaw.com\)](#)  
**Cc:** [Saira Alikhan](#)  
**Subject:** TESTOGEN-XR Opposition  
**Date:** Wednesday, January 14, 2015 10:13:33 AM

---

Hi Scott,

It was good talking with you and your colleague last week. Following up on that call, I wanted to see if you had a chance yet to gather that case law and/or applications you referred to as the basis for your counterclaims for fraud in the prosecution of our client's applications (*i.e.* that "FEN" and "TESTO" being allegedly recognized as descriptive abbreviations causes the TESTOFEN mark to have significance in the dietary supplement market). I'd like to avoid motion practice if possible, so if you have a basis for those counterclaims, I'd like an opportunity to see it.

Let me know. Thanks.

Sincerely,

Ryan M. Kaiser  
Amin, Talati & Upadhye, LLC.  
55 W. Monroe St.  
Suite 3400  
Chicago, IL 60603  
312.327.3328 direct  
312.466.1033 reception  
773.474.8271 cellular  
312.884.7352 fax  
[Ryan@AminTalati.com](mailto:Ryan@AminTalati.com)

NOTE: THE INFORMATION CONTAINED IN THIS EMAIL MESSAGE MAY CONTAIN ATTORNEY - CLIENT PRIVILEGED AND CONFIDENTIAL INFORMATION INTENDED ONLY FOR THE USE OF THE INDIVIDUAL OR ENTITY NAMED ABOVE. IF THE READER OF THIS MESSAGE IS NOT THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT ANY DISTRIBUTION OR COPYING OF THIS COMMUNICATION IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THIS COMMUNICATION IN ERROR, PLEASE NOTIFY US IMMEDIATELY BY TELEPHONE AT 312.327.3328.